

## **REMARKS**

### **FORMAL MATTERS:**

Claims 1-15 and 17-31 are pending in the instant application.

Claim 16 was previously canceled.

Claims 9, 14, and 18-37 were previously withdrawn from consideration.

No new matter is added.

### **WITHDRAWN REJECTIONS**

Applicants thank the Examiner for indicating that the provisional rejection of claims 1-8, 10-13, 15 and 17 on the ground of non-statutory obviousness-type double patenting over claims 30-37 of co-pending Application No. 11/183,477 is withdrawn in view of the Terminal Disclaimer filed March 2, 2010.

### **REJECTION UNDER 35 U.S.C. §103(a)**

Claims 1-8, 10-13, 15 and 17 were rejected under 35 U.S.C. §103(a) over Berry et al. WO 00/45790 ("Berry") and Chen et al. US 20030180364 ("Chen") in combination alone or in view of Kasraian et al. Pharm. Dev. And Tech., 4(4) 475-480, 1999 ("Kasraian") and Hunt US 20020064536 ("Hunt"). Applicants respectfully traverse the rejection as discussed below.

As an initial matter, Applicants note that the Office has incorrectly identified the publication numbers for both the Chen and Hunt references. Applicants presume that the Office intended to list US 20030180364 as the publication no. for the Chen reference as opposed to US 2003018036 as indicated on page 3 of the Final Office Action. Furthermore, Applicants presume that the Office intended to list US 20020064536 as the publication no. for the Hunt reference as opposed to US 20030064536 as indicated on page 3 of the Office Action. Clarification of this matter is respectfully requested.

The Office's §103(a) rejections depend at a minimum on the combination of the cited Berry and Chen references. However, the Chen reference is not available as prior art to the present application. The Chen reference was published on September 25, 2003, after the claimed priority date (March 31, 2003 filing date of U.S. Provisional Application No. 60/459,300) of the present application. Accordingly,

Chen does not qualify, for §103(a) purposes, as prior art under §102(a) or (b) by virtue of its publication date. Furthermore, Chen's §102(e) date cannot be relied upon because it is disqualified in view of §103(c) which indicates that "[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person" M.P.E.P. §2146. At the time the claimed invention was made, both the claimed invention and the Chen application were owned or subject to an obligation of assignment to the same person. Support for this assertion is provided by the following assignments. An assignment from the inventors to Alza Corporation was recorded for the Chen application on May 27, 2003 at reel/frame 014099/0091. Similarly, an assignment from the inventors to Alza Corporation was recorded for the present application on December 16, 2004 at reel/frame 016075/0786. Both the Chen application and the present application were subsequently assigned to Durect Corporation as evidenced by the documents recorded at reel/frame 021447/0909 and reel/frame 021247/0209, respectively. The USPTO recordation information for the referenced assignments is attached for reference.

Because Chen is required as part of the Office's §103(a) combination and because Chen is disqualified as prior art as discussed above, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness with respect to claims 1-8, 10-13, 15 and 17. Reconsideration and withdrawal of the rejection are respectfully requested.

**CONCLUSION**

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1953.

Respectfully submitted,  
BOZICEVIC, FIELD & FRANCIS LLP

Date: \_\_\_\_\_

12/7/2010

By: \_\_\_\_\_



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## Assignments on the Web &gt; Patent Query

## Patent Assignment Abstract of Title

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## Total Assignments: 2

Patent #: 7829109 Issue Dt: 11/09/2010 Application #: 10295603 Filing Dt: 11/14/2002  
Publication #: 20030180364 Pub Dt: 09/25/2003  
Inventors: Guohua Chen, Paul R. Houston, Lothar Kleiner, John Spaltro  
Title: CATHETER INJECTABLE DEPOT COMPOSITIONS AND USES THEREOF

## Assignment: 1

Reel/Frame: 014099/0091 Recorded: 05/27/2003 Pages: 4

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Assignors: CHEN, GUOHUA  
HOUSTON, PAUL R.  
KLEINER, LOTHAR W.  
SPALTRO, JOHN

Exec Dt: 05/07/2003  
Exec Dt: 05/07/2003  
Exec Dt: 05/07/2003  
Exec Dt: 05/03/2003

Assignee: ALZA CORPORATION C/O JOHNSON & JOHNSON  
1900 CHARLESTON ROAD  
MOUNTAIN VIEW, CALIFORNIA 94043

Correspondent: JOHNSON & JOHNSON  
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## Assignment: 2

Reel/Frame: 021477/0909 Recorded: 09/03/2008 Pages: 10

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Assignor: ALZA CORPORATION  
Assignee: DURECT CORPORATION

Exec Dt: 05/22/2008

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Correspondent: DAVID J. ABRAHAM  
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If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.1  
Web interface last modified: Apr 30, 2009 v.2.1

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## Total Assignments: 2

Patent #: NONE      Issue Dt:      Application #: 10814826      Filing Dt: 03/31/2004  
Publication #: 20050008661      Pub Dt: 01/13/2005  
Inventors: Pamela J. Fereira, Michael Desjardin, Catherine Rohloff, Stephen A. Berry  
Title: Non-aqueous single phase vehicles and formulations utilizing such vehicles

## Assignment: 1

Reel/Frame: 016075/0786      Recorded: 12/16/2004      Pages: 8

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Assignors: FEREIRA, PAMELA J.

Exec Dt: 10/21/2004

DESJARDIN, MICHAEL

Exec Dt: 09/29/2004

ROHLOFF, CATHERINE

Exec Dt: 10/22/2004

BERRY, STEPHEN A.

Exec Dt: 08/25/2004

Assignee: ALZA CORPORATION

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MOUNTAIN VIEW, CALIFORNIA 94043-7210

Correspondent: TRASKBRITT  
P.O. BOX 2550  
SALT LAKE CITY, UT 84110

## Assignment: 2

Reel/Frame: 021247/0209      Recorded: 07/15/2008      Pages: 10

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Assignor: ALZA CORPORATION

Exec Dt: 05/22/2008

Assignee: DURECT CORPORATION

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